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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	Group Art Unit: 1661
Josef Stefan Köhne)	
)	Examiner:
Serial No. 10/046,490)	Wendy Haas
)	
Filed: October 25, 2001)	
)	Docket No.
For: AVOCADO TREE NAMED)	BROKAW-40124
'MERENSKY 2')	
)	
)	

DECLARATION OF DR. JOSEF STEFAN KÖHNE

1. My name is Dr. Josef Stefan Köhne, and I am the inventor of the present patent application, and General Manager of Merensky Technological Services, the agribusiness research and development operation of Hans Merensky Holdings (Pty) Ltd., which owns the Westfalia Estate.

2. In the 1970's and early 1980's, widespread outbreaks of *Phytophthora cinnamoni* root rot had devastating effects on most avocado trees at the Westfalia Estate. An intensified avocado rootstock testing project was conducted based on trees which were observed and monitored over a few

years to have resistance to the root rot disease. This project resulted in the present Merensky 2 cultivar, which is the subject of the present patent application. Several years followed in which clonal propagation of the Merensky 2 rootstock cultivar was undertaken. Subsequent experimental plantings took place at various sites on farms belonging to Hans Merensky Holdings, and preliminary results obtained from these experimental plantings showed the rootstock to be promising in terms of resistance to the root rot disease thus warranting further testing.

3. The plants at Merensky Technological Services go through various phases before they are fully released to the industry. The first phase is an experimental testing phase. This consists of planting one-hundred trees or less per site in a statistical layout with control standards included, carried out by research staff of Merensky Technological Services who are also responsible for tree care. The second phase is what we term a "semi-commercial" testing. This consists of planting less than one thousand trees per site on one hectare or less in a non-statistical layout and maintained using standard agricultural practices. This testing is conducted by Hans Merensky Holdings, or under non-propagation and testing contracts entered into between Hans Merensky Holdings and reputable parties. The third phase is what we term "commercial testing" in which one thousand trees or more are planted per site on land under strict control of or owned by Hans Merensky Holdings, or under non-propagation and testing contracts entered into between Hans Merensky Holdings and reputable testers. Once all relevant answers to the aforementioned three stages have been gained, the plants are released to the industry. However, a purchase agreement prohibiting propagation of the plant material must be signed by the purchaser prior to receiving the plant material.

4. During the first and second experimental testing phases, budwood of various avocado rootstock selections, including the Merensky 2 cultivar, were made available under oral agreement to the University of California/Riverside - Department of Plant Pathology. It was agreed that the plant material provided would only be used for the academic testing of their potential value. Subsequently, when further plant material was exchanged between the University of California/Riverside and Hans Merensky Holdings, a formal written Non-Propagation and Bailment Agreement was entered into. This Agreement documented the protection of the present cultivar Merensky 2, and the terms and conditions of controls and experimental testing of the exchanged varieties. The testing is conducted under the control of Professor Dr. John Menge, of the University of California/Riverside. We at Hans Merensky Holdings have no information, or no reason to believe, that the plant material has been accessed or misused by outsiders at any time.

5. After the initial "experimental testing" first phase by Merensky Technological Services, a "semi-commercial" second phase planting was undertaken on one of the Hans Merensky Holdings' farms, called "Silverfontein", in order to further verify initial findings. A fellow researcher of mine, Denis J. Roe, gathered information from the above "semi-commercial" planting and reported to me.

6. As is common in the scientific world, and in particular to our field of endeavor, reports and publications concerning various experimental plants of interest are provided to fellow colleagues in symposiums or printed publications. However, the instant cultivar itself was not available to any outside person, skilled or otherwise, and was closely guarded at all times during these experimental testing phases. Of course, even a detailed report concerning an asexual plant does not enable even the most skilled person in

this art to reproduce the plant. Access to the plant itself must be had in order to reproduce the asexual plant. At all times mentioned above, Hans Merensky Holdings had full control over the testing of the Merensky 2 plant material, which was tested by their own employees on land owned by Hans Merensky Holdings, or under non-propagation and strictly controlled contracts and agreements with others, such as The University of California/Riverside. The testing was strictly for research purposes only. In fact, up to one year prior to the date of filing for the instant U.S. patent application, neither Hans Merensky Holdings, nor any other institution, company or corporation had placed the instant cultivar in the phase which we define as "commercial testing", which is still experimental in nature and strictly controlled.

7. The Merensky 2 cultivar was not in commercial use anywhere prior to the start of the South African spring of 2001 planting season, i.e. November of 2001.

8. I have read the February 7, 2003 Office Action. I disagree with the Examiner's assertion that the instant Merensky 2 cultivar is genetically equivalent to any of the other varieties listed in the patent application. I believe that the Examiner has misread this paragraph as it specifically states that "there were differences found between the 'Merensky 2' and the other varieties, and very clear differences found between the 'Merensky 2' and the 'Duke 7' variety". In fact, genetic testing performed by the Agricultural Research Council of South Africa on behalf of Merensky Technological Services prove that the instant cultivar 'Merensky 2' is genetically different from other known avocado trees and rootstocks.

9. With respect to the name discrepancy, originally, the South African Plant Breeder's Rights application was filed under the 'Merensky' name. However, Hans Merensky Holdings wished to trademark the name MERENSKY. Thus, the application name was changed to 'Dusa'. However, due to the fact that MERENSKY is a commonly shared name and surname in South Africa, our trademark application was rejected. It was then decided to rather trademark the name DUSA, hence the need to revert to the original cultivar name Merensky 2. Attached hereto as Exhibit A are various documents evidencing this name change between our company and the National Department of Agriculture of the Republic of South Africa.

The undersigned declares that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such false statements may jeopardize the validity of the application or any registration resulting thereon.

24. July 2003
Date

Dr. Josef Stefan Köhne
Dr. Josef Stefan Köhne